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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,882	01/26/2001	James D. Hempleman	PRE2519P0011US	6661

7590

02/14/2002

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EXAMINER

KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 02/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/770,882

Applicant(s)

HEMPLEMAN ET AL.

Examiner

Alford W. Kindred

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other:

### DETAILED ACTION

1. This action is responsive to communications: Application filed on 01/26/01.

#### ***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 30-45, are rejected under 35 U.S.C. 102(e) as being anticipated by ***Contois***, US# 5,864,868, 01/1999.

As per claim 30, Contois teaches "a source of works . . . an audio component . . . " (see fig. 4—sheet 4 of 8) building a displayable inventory of works . . . play list of works . . . " (see abstract) "additional instructions for creating an editing command . . . editing the displayed . . . "(see col. 5, lines 6-25).

As per claim 31, Contois teaches "presenting a play list to the output device" (see fig. 4—sheet 3 of 8).

As per claim 32, Contois teaches "a device for storage of digital representation . . . " (see col. 3, lines 61-65).

As per claim 33, Contois teaches "edit one of an audio output device . . . " (col. 4, lines 38-62).

As per claim 34, Contois teaches "a programmable processor" (see col. 6, lines 47-60).

As per claims 35 and 38, Contois teaches "analysis of the characteristics of works on a selected list" (see col. 9, lines 42-66).

As per claims 36 and 37, Contois teaches "sorting works accordance with a pre-selected parameter" (see abstract).

As per claim 39, Contois teaches "download a work on a selected play list . . ." (see fig. 1, whereas the serial MIDI (28) is used to download MIDI files).

As per claims 40 and 42, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 30 and are similarly rejected.

As per claim 41, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 33 and is similarly rejected.

As per claim 43, Contois teaches "displaying at least part of the edited list" (see fig. 3—sheet 3 of 8).

As per claims 44 and 45, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 39 and is similarly rejected.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 46-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Contois**, as applied to claims 30-45 above, and further in view of **Bernard et al.**, US# 5,918,213.

As per claims 46 and 47, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 34 and is similarly rejected including the following:

--Contois does not teach "royalty payment, or , billing information.

Bernard et al. teaches "royalty payment, or, billing information" (see col. 7, lines 38-55). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Bernard "royalty payment, or, billing information" (see col. 7, lines 38-55) with the teachings of Contois above, because using the steps of "royalty payment, or, billing information" would have given those skilled in the art the tools to track and gauge the purchasing of musical items.

As per claims 48-49, 58, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 30 and 46 and are similarly rejected.

As per claim 50, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 45 and is similarly rejected

As per claims 51-52, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 44 and are similarly rejected.

As per claims 53-55, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 42-43 and are similarly rejected.

As per claim 56, this claim is are rejected on grounds corresponding to the arguments given above for rejected claim 30 and are similarly rejected.

As per claim 57, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 36 and is similarly rejected.

As per claim 59, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 44 and is similarly rejected.

As per claim 60, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 50 and is similarly rejected.

As per claim 61-62, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 37 and are similarly rejected.

As per claims 63 and 66, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 48 and 50 are similarly rejected.

As per claims 64-65, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 37 and are similarly rejected.

**Conclusion**

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-746-7239 (**formal** communications intended for entry),

Or:

(703)-746-7240 (**informal** communications labeled **PROPOSED** or  
**DRAFT**).

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

Alford Kindred, whose telephone number is (703)-305-3802 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu, can be reached at (703)-305-4393.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)-305-3900.

Alford W. Kindred

